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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,040	04/21/2000	James S. Ellis	K35A0603	6502

26332 7590 08/27/2003

WESTERN DIGITAL CORP.
20511 LAKE FOREST DRIVE
C205 - INTELLECTUAL PROPERTY DEPARTMENT
LAKE FOREST, CA 92630

EXAMINER

THOMPSON JR, FOREST

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/557,040

Applicant(s)

ELLIS ET AL.

Examiner

Forest Thompson Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (See Paper #2). The text of those sections of Title 35, U.S. Code not otherwise provided in a prior Office action will be included in this action where appropriate.
2. This action is responsive to applicant's Request for Reconsideration (see Paper #3) filed on 06/11/2003 (see Paper #4). Applicant argues the merits of the prior art, Hawkins et al. (U.S. Patent No. 6,029,146), as applied in the rejection. Applicant specifically requests that examiner particularly point out where Hawkins discloses "a plurality of investment instruments, "a means for apportioning", and "a means for receiving" as recited in applicants' claim 1, so that Applicants have a full and fair opportunity to respond to this rejection. Claims 1-32 were not amended, and are pending.
3. Claims 1-32 have been examined.

Claim Rejections - 35 USC § 102

1. Claims 1-32 were rejected in Paper #2 under 35 U.S.C. 102(a) as being anticipated by Hawkins et al. (U.S. Patent No. 6,029,146). Applicants' arguments have overcome this rejection. Therefore, examiner is withdrawing the rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (U.S. Patent No. 6,029,146), and further in view of Official Notice.

7. Applicants' invention presents claims in the context of a system and method for executing buy orders for purchasing computer components. However, analogous art includes any prior art that discloses the invention and/or functionality claimed by applicants for any products or services, and this prior art may be used to reject

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applicants' invention. Examiner considers Hawkins et al. as one such appropriate prior art.

8. Claims 1-32: Official Notice is taken that fees were old and well known in the art as illustrating factors of ownership and service provided. Such fees may encompass providing monetary value to owners of an interest in products or services for the use or exchange of these products or services. The fees disclosed by Hawkins et al. at col. 14 lines 39-48 and col. 17 lines 42-46, and further presented at fig. 12 [674], are consistent with these fees, and present components of Hawkins' invention that may be construed as (1) prior art, and (2) indication of ownership of shares. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the invention of Hawkins et al to explicitly provide components of the invention that encompassed shares of ownership and monetary exchanges related to ownership factors, as disclosed by old and well known art, for the motivation of compensating owners/systems for the exchange of products and services. Additionally, specific disclosures of Hawkins et al. are identified below that, when used in concert with this disclosure, disclose applicants' invention.

Claims 1, 18. In an exchange server complex for computer component exchange in a network, a method for executing buy orders for purchasing computer components,

- an exchange server complex electrically connected to the network (col. 4 line 64 – col. 5 line 18);

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- a plurality of investment instruments comprising shares of ownership interests in the exchange server complex, at least one of the shares associated with the first or the second owner-processor thereby representing the ownership interest in the exchange server complex for the proprietor of the respective owner-processor (col. 14 lines 39 – col. 15 line 12), as inferred through the payment of fees to the brokers and system in connection with transfers of securities; and
- accounting data representing allocation of net profits among the owner-processors that are associated with the shares, the net profits being extracted from fees charged for transactions in the exchange server complex (col. 14 lines 39 –col. 15 line 12), as inferred through the payment of fees to the brokers and system in connection with transfers of securities;
- the network is electrically connectable to a plurality of owner-processors, the owner-processors having proprietors, at least one proprietor having an ownership interest in the computer component exchange (col. 14 lines 39 –col. 15 line 12), as inferred through the payment of fees to the brokers and system in connection with transfers of securities.
- each of the plurality of owner-processors are capable of being associated with one or more shares representing the respective proprietor's ownership in the exchange server complex, at least a first owner-processor adaptable to transmit electronic buy orders through the network for purchasing computer components, at least a second owner-processor adaptable to receive buy orders from the network (col. 3 line 48 – col. 4 line 3; col. 14 lines 39 –col. 15 line 12), as inferred through the transfer of orders and

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the settlement/payment of fees to the brokers and system in connection with transfers of securities,

- the method comprising the steps of:
- receiving one or more buy orders for computer components from the first ownerprocessor (col. 3 line 48 – col. 4 line 3);
- matching the one or more buy orders with a second owner-processor (col. 3 line 48 – col. 4 line 3);
- calculating a fee for matching the buy order with the second owner-processor (col. 14 lines 39-48);
- charging the calculated fee to at least the first or second owner-processor, or to both the first and second owner-processors (col. 14 lines 39-48; col. 17 lines 42-46);
- calculating a net profit resulting from charging the calculated fee (fig. 12 [674]; col. 14 lines 39-48); and
- apportioning the net profit based on the number of shares associated with each owner-processor (col. 14 line 10 – col. 15 line 12).
- updating the accounting database based on the apportioning of the net profit (fig. 12 [600]; col. 14 line 10 – col. 15 line 12).

Claims 2 ,3, 19. The method of claim 18, comprising providing incentives for the proprietors of each of the owner-processors to place or receive buy orders with the exchange server complex by associating one or more shares with the owner-processors

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that place or receive a threshold number of buy orders (col. 14 lines 10-55; col. 17 lines 42-46).

Claims 4, 20. The method of claim 18, comprising withdrawing payment for the second owner processor from an electronic escrow account associated with the first owner-processor after the proprietor of the first owner-processor receives the computer components that the buy order was for (col. 14 line 58 – col. 15 line 12).

Claims 5, 21. The method of claim 18, wherein the step of charging the calculated fee comprises electronically debiting a bank account associated with the first owner-processor (col. 14 line 57 – col. 15 line 12).

Claims 6, 22. The method of claim 18, wherein step of charging the calculated fee comprises electronically debiting a bank account associated with the second owner-processor (col. 14 line 57 – col. 15 line 12).

Claims 7, 23. The method of claim 18, wherein the step of charging the calculated fee comprises electronically debiting a first bank account associated with the first owner-processor and a second bank account associated with the second owner-processor (col. 14 line 57 – col. 15 line 12).

Claims 8, 32. The method of claim 18, wherein the step of apportioning comprises electronically crediting a bank account associated with each of the plurality of owner-processors that are associated with shares based on the number of shares associated with each respective owner-processor (col. 17 lines 42-46).

Claims 9, 24. The method of claim 18, wherein the step of matching comprises matching a set of requirements in the buy order with the second owner-processor if the second owner processor indicates that a proprietor of the second owner-processor is able to supply computer components that meet the set of requirements (Abstract; col. 3 lines 27-38).

Claims 10, 25. The method of claim 24, wherein the set of requirements are in an electronic commerce standard format (col. 3 lines 27-38).

Claims 11, 26. Hawkins et al. does not specifically disclose the electronic commerce standard format comprises a bill of materials format as described by ROSETTANET. Hawkins et al. does disclose *an originating broker 100 will transmit a message to an executing or regional broker 101 to buy or sell securities in the SWIFT MT502 format. The message will be transmitted from a user's workstation via the public data network (PDN) and will be stored on a host machine 102. The host 102 will store the message until the executing broker 101 manually connects to the host 102 and downloads the data. The data will then be presented to the regional broker 101 on his*

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or her workstation in a combined MT502/MT5S18 format (col. 7 lines 47-56). Official Notice is taken that any old and well known, acceptable/compatible format could be used in this context. ROSETTANET was such an old and well-known format (e.g., see U.S. Patent Application Publication No. 2001/0047322). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the disclose modify the disclosure of Hawkins et al. to explicitly format data, including bills of material, in a format as described by ROSETTANET, or any other old and well known format, as disclosed by old and well known art, for the motivation of executing buy orders on a network in a compatible manner among trading partners.

Claims 12, 27. The method of claim 18, comprising referring either the first, second or both the first and second owner-processors to a value added service (col. 14 lines 39-48), as inferred through the charging of the value-added tax and a shared commission.

Claims 13, 28. The method of claim 27, comprising charging a referral fee to the value added service 2 after the step of referring (col. 14 lines 39-48), as inferred through the charging of the value-added tax and a shared commission.

Claims 14, 29. The method of claim 28, comprising apportioning the fee received from the value added service as part of the net profit among the owner-processors based on the number of shares associated with each owner-processor (fig. 21 [641, 642, 643, 645, 646, 654, 656]; col. 14 lines 39-48).

Claims 15, 30. The method of claim 29, wherein the value added service comprises a computer component shipping agent for providing transportation of the computer components that are for the buy order, the computer components being shipped from a proprietor of the second owner-processor to the proprietor of the first owner-processor (fig. 15 [500, 502, 504, 506, 508, 524, 526]).

Claims 16, 17, 31. The method of claim 18, comprising publishing statistics based on a plurality of buy orders received from a plurality of the owner-processors that are each matched with at least one other owner-processor, wherein the step of publishing comprises presenting an electronic ticker tape for display on an attached monitor of one or more of the owner processors for informing a proprietor of each respective owner-processor of closing prices per unit by type of computer component in the latest buy order in time that was matched with an owner-processor for each type of computer component (fig. 18 [900, 920]; fig. 22 [302]; col. 16 lines 8-19).

Response to Arguments

9. Applicant's arguments, see Paper #3, filed 06/11/2003, with respect to claims 1-32 have been fully considered and are persuasive. The rejection of claims 1-32 in Paper #2 has been withdrawn.

Conclusion

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10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art includes:

- Plate et al. (U.S. Patent Application Publication No. 2001/0047322) which discloses, in order to promote interoperability and reduce cost of entry the protocols are XML based and conform to open standards such as those being developed by RosettaNet or UCCNet..

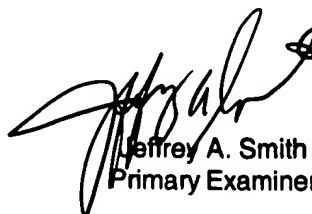
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

FT

August 22, 2003



Jeffrey A. Smith
Primary Examiner